

### REMARKS

Claims 1-19 and 21-36 are pending in the application. Claims 1, 5, and 8 have been amended as indicated above to correct typographical errors and to clarify language.

#### Rejection over Perronin:

In the most recent Office action of November 3, 2003 (OA), the Examiner has rejected pending claims 1, 3-10, 21-23, 31, and 33 under 35 USC § 102 (b) as anticipated by Perronin et al. The examiner states that (OA, page 2):

Perronin discloses the preparation of pigmentary particles coated with an organic polymer. Perronin discusses the importance of pigments in many fields such as cosmetics. Note column 1, lines 10-12. Example 11 provides a composition with 100 parts [of] a pigment, 350 parts heptane, 27 parts methyl methacrylate, and 12 parts acrylic acid.

The Examiner notes that the preamble language “nail enamel composition” does not hold patentable weight without reciting a structural limitation.

Further, in responding to previous arguments by applicants, the Examiner points out that (OA, page 3):

the inventive formulation of a solvent and polymer, does not recite any ingredients that differentiate it from the prior art. The prior art also clearly discloses a solvent, pigment, and polymer composition. Therefore, the instant claims are not distinguishable over the prior art merely due to the preamble. Clearly it can be seen from column 1, lines 12, that Perronin's composition is also used in the cosmetic field.

The applicants respectfully disagree that Perronin et al. ('007) anticipates, within the meaning of 35 U.S.C. § 102 (b), those claims subject to this rejection for the following reasons.

Anticipation requires the disclosure, in a single prior art reference, of each element of the claim under consideration. W.L. Gore & Assoc. v. Garlock, Inc. , 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Here, claim 1 is directed to a nail enamel composition comprising 10-95% by weight of a solvent, and 5-95% by weight of a specified polymer material. That polymer material is required by the claim to be capable of forming a film on the nail, have a glass transition temperature in the range of 5-90° C and further provides that the copolymer be a product of two different types of defined monomers where one monomer is a nonpolar ethylenically unsaturated monomer and the other monomer is a polar monomer of defined structure. The claim further provides that the polar monomer is present in about 2 to 29 % by weight of the total polymer. The claim also provides that the composition must be free of monomers containing acetoacetoxy moieties.

While it can be argued that Perronin discloses compositions which include a combination of a pigment with certain copolymer materials. A careful reading of the reference makes clear that Perronin does not describe or provide each and every limitation of the present claim 1.

Initially it should be noted that Perronin does not set forth any glass transition temperature for the disclosed composition. Similarly, Perronin does not describe or disclose the requirement that the polar monomer must be present in an amount by weight of about 2 to 29 % by weight of the total polymer. Also, Perronin. fails to describe the percentages of the solvent with respect to the copolymer as presently claimed. The absence of these parameters, which are required by the present claim 1, is likely due to the fact that the product being described by Perronin is completely different from the presently claimed inventive composition.

Applicants note that the product being described or disclosed by Perronin differs materially from the product of the present claims as particularly exemplified by pending claim 1.

Initially, applicants would note that portion at column 2, lines 28-46 which reads in pertinent part:

According to the present invention therefore a process is provided for the preparation of pigmentary compositions which comprises coating the particles of pigments by means of a polymer or copolymer, by covering by the polymerization or copolymerization *in situ* . . . wherein the reaction is effected in a medium comprising at least one organic solvent in which the monomer is soluble, and in the presence of at least one catalyst soluble in the medium, the monomer and the proportion thereof, being selected **so that the polymer or copolymer formed is insoluble in the organic solvent used**, . . . (Emphasis added).

This portion of Perronin makes clear that the nature of the composition being described differs significantly from that which is presently claimed. Initially, Perronin is seeking to coat the pigment particles with the polymer or copolymer portion of the composition. Note for example Examples 1 and 2 appearing in columns 4 and 5 of Perronin where the solvent is removed from the polymer/copolymer product upon completion of the polymerization process. This differs from that of the presently claimed composition where the copolymer is intended to be soluble in or dispersed in the solvent containing composition as described (See Specification, page 4, lines 16-18):

[t]he term "film forming polymer" means a polymer that is soluble or dispersible in the solvent of the nail enamel composition and is capable of remaining soluble or dispersible, without settling out, in the composition, during the shelf life of the product.

In addition, applicants would urge that the Examiner's conclusion that Perronin's composition is used in the cosmetic field does not find basis in the reference itself. The portion of the reference cited by the Examiner at column 1, line 12 reads:

The use of pigments, that is dyes insoluble in any medium, is much in demand in fields of application as varied as plastics, inks, textiles, paints, and cosmetics, to mention only the principle of these.

Here, Perronin et al. are describing the various fields that pigments and dyes are known to used. The reference stops short of ever stating that the compositions described and disclosed, and which form the basis of the Examiner's rejection, are useful in the cosmetic field. Note for example the disclosure at column 4, lines 51-55 which states:

They may be advantageously used in numerous fields of application, such as the pigmentation of collodions for spinning, inks, plastics materials, pints, creams or other coloured preparations.

None of these applications would readily suggest the use of such a composition in a cosmetic and particularly not in a nail enamel composition as presently claimed.

Thus, as to pending claim 1 and claims 3-10 and 21-23, which dependent, directly or indirectly thereon, Perronin fails to teach or describe each and every element of the claimed composition. Similarly, with rejected claims 31 and 33, Perronin fails to disclose a composition having glass transition temperature in the range of 5 to 90° C as required by the claims. Also, Perronin does not describe or disclose the requirement that the polar monomer must be present in an amount by weight of about 2 to 29 % by weight of the total polymer.

Applicants would further note that the composition of Example 11 of Perronin, referenced by the Examiner at page 2 of the most recent Office Action, does not fall within the scope of the present claims. Based on the listed ingredients, and their relative proportions to each other, it is evident that the 12 parts of acrylic acid makes up 30.8 % of the total polymer portion of the disclosed composition [Total polymer is 27 parts methacrylate plus 12 parts acrylic acid.] This is outside the claim limitation, which requires that this polar monomer be present in an amount of 2-29% by weight of the total polymer (See claim 1). Thus, this particular embodiment does not fall within the scope of the claimed invention as set forth in pending claim 1.

Thus, with regard to these claims, Perronin ('007) fails to disclose every limitation present in the claims and fails to describe or disclose a single embodiment which falls within the scope of the present claims. Therefore Perronin ('007) cannot reasonably be said to anticipate the claimed invention within the meaning of 35 U.S.C. §102(b).

In view of these arguments, applicants respectfully request that the Examiner reconsider and withdraw the rejection of the mentioned claims as unpatentable over Perronin.

**REJECTIONS OVER BEDNAREK ET AL.:**

The Examiner has additionally rejected claims 1, 3-12, 14, and 21-34 under 35 U.S.C. §102(e) as unpatentable over Bednarek et al. ('878). The Examiner, also, has relied upon Bednarek ('878) in rejecting claims 2, 13, and 15-16 under 35 U.S.C. §103(a) and further relies on Bednarek ('878) taken in combination with Pagano et al. ('988) in rejecting claims 17-19 and 35-36 under 35 U.S.C. §103(a). In so doing, the Examiner has relied upon the disclosure of Bednarek ('878) stating (OA, page 4):

Bednarek et al disclose a nail polish composition containing acrylic polymers. The composition comprises a solvent system having no more than 30% water, 0.1-30% of a pigment, a film forming acrylic binder prepared from methacrylic monomer, and styrene and which further contains adhesion promoting monomers. See abstract. Example 1 discloses titanium dioxide or red iron oxide pigment (pigment), 0.1-15% bentonite clay (suspending agent), 3-10% dibutylphthalate plasticizer, butyl acetate solvent, and 40% acrylic polymer (20/70/10 wt. % butylmethacrylate-co-methacrylate-co-acrylic acid.

Applicants would note that the Bednarek patent, U.S. 6,254,878 issued July 3, 2001 and has a filing date, and therefore an effective date under 35 U.S.C. §102(e), of July 1, 1999.

Applicants would, also, note that the present application was filed April 26, 2001, with claimed benefit under 35 U.S.C. §120 of the filing date of Provisional Application 60/202,106 having a filing date of May 4, 2000. Thus, the effective filing date of the present application is May 4, 2000, which is less than 1 year after the effective date of the Bednarek patent.

With this response applicants includes a Declaration, signed by 4 of the 5 named inventors which declares and evidences that applicants had conceived of and reduced to practice the presently claimed invention prior to the earliest effective date of the Bednarek patent. From this document it can be seen that the invention claimed in this application was made and reduced to practice by at least November 10, 1997, which is well prior to the July 1, 1999 effective date of the Bednarek ('878) patent.

Thus, applicants would urge that those rejections based on the disclosure of Bednarek ('878) be withdrawn since applicants have established that the 102(e) date of the reference was not before the invention date thereof by the applicant for patent.

With regard to claims 27-32, applicants would like to add that the disclosure of Bednarek ('878) in the Example 1, referenced by the Examiner, specifically requires the presence of 40% acrylic polymer made up of butylmethacrylate-co-methacrylate-co-acrylic acid, with the monomers being present in a weight percentage of 20/70/10 wt. %. This differs from claims 27-32 which include, either explicitly or based on dependency, the closed language "consisting of". Thus, these claims limit the monomers, which may be present in the copolymer material to butylmethacrylate, and a polar monomer selected from the group consisting of acrylic acid, methacrylic acid and mixtures thereof. Excluded from these claims is a copolymer including the additional "methacrylate" present in the embodiment of Example 1 of Bednarek ('878). Similarly, these claims would also be fairly read to exclude the presence of "styrene" monomer which is disclosed in the other examples of Bednarek ('878). Thus, these claims are not anticipated by this reference, and applicants request that the Examiner reconsider the rejections under 35 U.S.C. §102(e) and 35 U.S.C. §103(a) of these claims as being unpatentable over Bednarek either taken alone or in combination with Pagano ('988).

Thus, applicants would, respectfully, request that the Examiner reconsider the rejections of claims 1 - 19 and 21-36 for the reasons set forth above.

**Conclusion:**

In conclusion, applicants have presented arguments which demonstrate that Perronin fails to anticipate claims 1, 3-10, 21-23, 31, and 33. Further, the Declaration under 35 U.S.C. § 131 and arguments relating to those rejections based on Bednarek ('878) should be persuasive to overcome those rejections.

Applicants submit an Information Disclosure Statement to cite additional references they wish to make of record. The Examiner is respectfully requested to review and consider the cited references along with the filing of an RCE for this application, this amendment, and the Declaration of Anjali Patil.

Respectfully Submitted,

  
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